

REMARKS/ARGUMENTS

The non-final office action of February 3, 2005 (hereinafter the Action) has been carefully reviewed and these remarks are responsive thereto. Upon entry of this amendment, claim 18 is cancelled without prejudice or disclaimer. Claim 62 is added, although no new matter has been added. Reconsideration and allowance of the instant application are respectfully requested.

Claim Rejections under 35 U.S.C. § 112

The Action rejected claims 1-18, 44, 47-51, 60-61 under 35 U.S.C. § 112, ¶ 1 for failing to comply with the enablement requirement. Applicants respectfully traverse these rejections and request that the claims be allowed. The Action cites *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) for the proposition that “a claimed invention must be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” According to *In re Wands*, it is improper to conclude that a disclosure is not enabling based on an analysis of only one factor (from among several factors for determining “undue experimentation”) while ignoring one or more of the others. The factors for determining “undue experimentation” include (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. The Action must consider *all* the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. MPEP § 2164.01(a).

Applicants respectfully assert that the Action has not properly considered all the evidence in determining whether a person of ordinary skill in the art is able to make and use the invention without undue experimentation. Applicants further assert that there is sufficient information provided within the specification to enable one of ordinary skill in the art to make and use the invention. Rather than evaluating each of the above factors, the Action merely sets forth several questions and statements, all of which are sufficiently addressed within the specification. Each of the specific questions and arguments is set forth and addressed below in some detail.

The Action alleges that the specification does not provide enablement for (1) how the inferencing engine uses data to derive and reason a consequence or (2) how the analytics console analyzes the data. With regard to (1) an inferencing engine using data to derive and reason a consequence, several examples and explanations are offered throughout the specification. For example, in the specification, paragraphs 47-48, 65-68, 72-74, and 109-113 discuss a handful of examples of the use of data to derive and reason a consequence. Other examples appear elsewhere in the specification. With regard to (2) how the analytics console analyzes the data, although the specification sufficiently describes an analytics console, the single claim including an analytics console has been cancelled without prejudice or disclaimer.

The Action further alleges that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, (3) to make and use an inferencing engine that generates the consequences or (4) make and use the analytics console to determine relationships to enable the invention commensurate in scope with these claims. Once again, with regard to (3) the making and using of an inferencing engine that generates consequences, examples of the making and use of an inferencing engine are provided throughout the specification. Applicants especially note Figure 3 and the accompanying paragraphs 65-71, which provide one example of an inferencing engine. With regards to (4) making and using an analytics console, as previously noted the specification sufficiently describes an analytics console. Nevertheless, the claim including an analytics console has been cancelled without prejudice or disclaimer.

The Action goes on to question (5) who or what and how are the consequences generated with “reason”? (6) How is the information derived? (7) What algorithms are used to generate consequences? (8) What data is used in the generation of the consequences and how is it used? With regard to question (5), previously cited are examples of inferencing engines generating consequences using rules. Furthermore, examples of conclusions are further provided in paragraphs 95, 97, 99, and 150. With regard to question (6), it is not clear what is meant by information. With regard to question (7), examples of algorithms used to generate consequences are provided throughout the specification, notably in paragraphs 109-115, and 129. With regard to question (8), numerous examples of source data are provided throughout the specification, including paragraphs 72-74, and 124.

The Action also asks, “[W]hat exactly is an analytics counsel [sic]? How does a what if statement determine a new relationship? What is the basis of determining relationships? What data is used and how does the analytics console use the data to make this determination?” As described in paragraphs 57 and 78, an analytics console may assist in “better understanding” of a class of users and also spot “trends” of a user population. Again, although Applicants believe that an analytics console is sufficiently described in the specification, claim 18, which recites this feature, has been cancelled without prejudice or disclaimer.

In addition to the above claims, the Action rejected claims 19-46 and 52-59 under 35 U.S.C. § 112, ¶ 1 as well for failing to comply with the enablement requirement. Applicants respectfully traverse these rejections and request that the claims be allowed. Each of the specific questions and arguments raised in the Action is set forth and addressed below in some detail.

The Action alleges that “the disclosure does not enable one skilled in the art to know how ... conclusions are drawn, what is used to draw the conclusions and what and when is the basis for drawing conclusions.” Applicants counter that the specification does indeed enable those skilled in the art to understand how conclusions are drawn and what is used to draw the conclusions. Examples of conclusions and their basis are provided throughout the document, including paragraphs 65-71, 109-115, 121, and 129.

The Action further alleges that “the disclosure does not enable one skilled in the art to understand the weighting system to an extent that they are able to re-create it. How does one data set get a designated weight and a different data set gets a completely different weight designation? What is the basis for weighting the nodes and when, how and by who or what is the data weighted?” Weighting of nodes is described throughout the application, with examples provided in several figures, including Figures 18 and 21. For example, from paragraph 75, “The [personalization interest graph] can be considered as a subset of the ontology, but different in that nodes also have associated weights indicating their importance to the user.” Further examples of weighting are provided in paragraphs 76, 114-115, 121, 126, and 129.

Renewal of Arguments

Arguments from Applicants’ previous remarks with regard to claims 1, 19, 31, 40, 41, 47, 52, and 57 have been addressed in the Action. Previously, the listed claims were rejected under

35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,151,584 to Papierniak *et al* (hereinafter *Papierniak*). Although it is unclear whether the previous rejection under *Papierniak* still stands, Applicants respectfully traverse the arguments made by the Action.

The Action states, “the features upon which the applicant relies (i.e., nodes) are not recited in the rejected claims ... limitations in the specification are not read into the claims.” However, the Action does not take into consideration amendments made to the cited claims. The previously amended claims did indeed state features upon which Applicants’ previous arguments were based. For example, previously amended claim 1 recites:

A system for providing personalized content to a user, comprising:
a data warehouse that stores user data corresponding to a user;
an ontology having *a collection of nodes* representing related concepts and a plurality of relationships among the collection of nodes;
an inferencing engine that generates consequences based on information in said data warehouse, wherein said user data is tagged in accordance with *the collection of nodes* of said ontology.

[Emphasis added] The Action further argues that an ontology having a collection of nodes is disclosed in *Papierniak* at col. 13, lines 17-23: “the processed data must be organized in a structured way.” *Papierniak* neither explicitly nor implicitly describes each and every element of claims 1, 19, 31, 40, 41, 52, and 57. Organizing data in a structured way does not teach or even hint at an ontology and/or a collection of nodes representing related concepts and a plurality of relationships among them, features which are present in each of the listed claims. Moreover, in reference to claims 1, 19, 31, 40, and 41, *Papierniak* does not disclose tagging user data in accordance with an ontology. With respect to claims 47, 52, and 57, *Papierniak* makes no reference to content tagged in accordance with an ontology.

The Action also argues that tagging user data in accordance with the collection of nodes of said ontology is disclosed in *Papierniak* at col. 18, lines 45-48: “classifications such as characterizations, customer descriptions, preference determination, and behavior patterns.” However, this does not teach or suggest tagging user data in accordance with the collection of nodes of an ontology. Classifications do not amount to “tagging user data,” let alone tagging user data in accordance with an ontology.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 20, 24, 51, and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Papierniak* in view of the website www.financialengines.com, as archived at www.archive.org on October 12, 1999 (hereinafter [financialengines.com](http://www.financialengines.com)). Claims 16 and 17 appear to also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Papierniak* in view of the website www.medscape.com, as archived at www.archive.org on February 29, 2000 (hereinafter [medscape.com](http://www.medscape.com)). The Action maintained the rejection and found the previous arguments to be non-persuasive.

Applicants respectfully traverse these rejections, and assert that the combinations of *Papierniak* with either [financialengines.com](http://www.financialengines.com) or [medscape.com](http://www.medscape.com) are improper. The Action does not provide a proper motivation to combine the references, nor was one provided in the previous office action. There is no suggestion in any of the references to make the combination asserted here. Moreover, Applicant asserts that at least the claim features (e.g., user data tagged in accordance with the collection of nodes of said ontology) cited above as not being taught or suggested by *Papierniak* are also not disclosed by either [medscape.com](http://www.medscape.com) or [financialengines.com](http://www.financialengines.com). Therefore, their combination, improper as it may be, still does not fix this problem.

Claim Rejections under In re Gulack

The Action alleges that the articles of claim 60 and the advertisements of claim 61 are merely nonfunctional descriptive material which do not distinguish the claimed invention from the prior art in terms of patentability. Applicants respectfully assert that the nature of the content provided by the invention is more than merely descriptive, and respectfully traverse the arguments of the Action. The articles and advertisement are selected “based at least in part on the [personal interest graph],” features of the claims which the Action ignores, and which are not taught or suggested by *Papierniak*.

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CONCLUSION

Applicants respectfully submit that claims 1-17, and 19-62 are presently in condition for allowance and a Notice to that effect is respectfully requested. Should the Examiner believe that further discussion and/or amendment would be helpful, the Examiner is respectfully invited to telephone Applicant's undersigned representative at the number listed below. Applicant hereby petitions for any extensions of time which may be required, except for payment of the issue fee. The Commissioner is hereby authorized to charge to deposit account number 19-0733 any fees necessary to maintain the pendency of the present application.

Respectfully submitted,

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